# TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1900.

No. 187.

A. LESCHEN & SONS ROPE COMPANY, APPELLANT,

vs.

BRODERICK & BASCOM ROPE COMPANY.

APPEAL FROM THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE EIGHTH CIRCUIT.

FILED MARCH 8, 1900.

(19,046.)

(19,646.)

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*vs.*

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JUDD & DETWEILER (INC.), PRINTERS, WASHINGTON, D. C., OCTOBER 2, 1905.

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a Pleas and proceedings in the United States circuit court of appeals for the eighth circuit, at the December term, 1904, of said court, begun and held at the United States court house in the city of St. Louis, Missouri, on the first Monday in December, to-wit: the fifth day of December, A. D. 1904, before the Honorable Walter H. Sanborn and the Honorable Willis Van Devanter, circuit judges, and the Honorable Charles F. Amidon, district judge.

Attest:

[Seal United States Circuit Court of Appeals, Eighth Circuit.]

JOHN D. JORDAN,
Clerk of the United States Circuit Court
of Appeals for the Eighth Circuit.

Be it remembered that heretofore, to-wit: on the twenty-sixth day of March, A. D. 1904, a transcript of record, pursuant to an appeal allowed by the circuit court of the United States for the eastern district of Missouri, was filed in the office of the clerk of the United States circuit court of appeals for the eighth circuit, in a certain cause wherein A. Leschen and Sons Rope Company was appellant, and The Broderick and Bascom Rope Company was appellee, which said transcript of record is in the words and figures following, to-wit:

1 UNITED STATES OF AMERICA:

The President of the United States to Broderick & Bascom Rope Company, Greeting:

You are hereby cited and admonished to be and appear at a United States circuit court of appeals for the eighth circuit, at the city of St. Louis, Missouri, within sixty days, pursuant to an appeal filed in the clerk's office for the circuit court of the United States, eastern district and division of Missouri, wherein A. Leschen & Sons Rope Company is appellant and you are appellee, to show cause, if any there be, why the decree rendered against the said appellant as in said appeal mentioned, should not be corrected, and why speedy justice should not be done to the parties in that behalf.

Witness, the Honorable Elmer B. Adams, judge holding circuit court of the United States this 25th day of March, in the year of our Lord one thousand nine hundred and four.

ELMER B. ADAMS.

Attest:

—— ——, Clerk.

Service accepted.

DAWSON & GARVIN,
Attorney- for Appellee.

No. 4852. United States circuit court eastern district & division of Missouri. A. Leschen & Sons Rope Co. *vs.* Broderick & Bascom Rope Co. Citation. Filed Mar. 25, 1904. James R. Gray, clerk.

1—187

UNITED STATES OF AMERICA,
Eastern Division of the Eastern Judicial } ss:
District of Missouri,

In the Circuit Court of the United States in and for the Eastern Division of said District.

Be it remembered, that on the 8th day of May, A. D. 1903, there was filed in the clerk's office of said court, a certain bill of complaint, which is in words and figures as follows, to-wit:

2 United States Circuit Court, Eastern District and Division of Missouri.

A. LESCHEN & SONS ROPE COMPANY
vs.
BRODERICK & BASCOM ROPE COMPANY. } In Equity.

Bill of Complaint.

To the honorable the judges of the circuit court of the United States for the eastern division of the eastern judicial district of Missouri:

Now comes the A. Leschen & Sons Rope Company, a corporation organized and existing under the laws of the State of Missouri, and having its principal office and place of business in the city of St. Louis, said State, and a citizen of said State, and brings this its bill of complaint against the Broderick & Bascom Rope Company, a corporation organized and existing under the laws of the State of Missouri, and having its office and principal place of business in the city of St. Louis, said State, and a citizen of said State.

And thereupon, your orator, The A. Leschen & Sons Rope Company, humbly complaining shows unto your honors:

First. That your orator was incorporated under the laws of the State of Missouri, in the year 1886, and that its corporate charter still remains in full force and effect.

Second. That the defendant is a corporation duly organized under the laws of the State of Missouri, about the year 1882 and that its corporate charter still remains in full force and effect.

Third. That your orator has, ever since, it was incorporated, been engaged in the manufacture and sale of wire ropes or cables in the said city of St. Louis, and that in the year 1888 it adopted for its use as a trade-mark for its highest and best grade of wire rope, a strand of a different color from the other strands of the rope, the said trade-mark then and now being effected by your orator by painting one of the strands of the rope so as to make it distinctly unlike the other strands of the rope, a sample of said rope bearing said trade-mark being herewith filed and marked "Exhibit A."

Your orator shows unto your honors that it has continuously used this trade-mark from the time that it was first adopted down to the present day and that said make of rope to which said trade-mark has been applied by your orator has been extensively advertised by your orator at great expense to your orator and that your
3 orator's sales of wire rope identified and made known by said trade-mark have been very great, aggregating in the past to upwards of eight million feet, and consists at the present of from about 70 to 75 thousand feet per month.

Fourth. Your orator further shows unto your honors that having so adopted said trade-mark and being the sole and exclusive owner thereof it did on or about the 4th day of December 1900 obtain a registration of said trade-mark in the office of the Commissioner of Patents of the United States said registration being No. 35,552, and a copy of which is hereto attached and marked "Exhibit B," and which registration, or a certified copy thereof is ready here in court to be produced.

Fifth. Your orator further shows unto your honors, on information and belief that early in the year 1900 the defendant, The Broderick & Bascom Rope Company, commenced to paint one of the strands of its wire rope so as to make it of a distinctly different color from the other strands of the rope, a sample of which is herewith filed and marked "Exhibit C," and that thereafter, to-wit: on or about the 31st day of October 1900, the defendant, The Broderick & Bascom Rope Company filed an application in the office of the Commissioner of Patents of the United States for a registration of a trade-mark for wire rope consisting, when amended, of one of the strands being of a different color from the other strands, a certified copy of the file wrapper and contents of said application being herewith filed and marked "Exhibit D."

Sixth. Your orator further shows unto your honors that subsequent to the filing of said application for registration by the defendant, such proceedings were had that on or about the 9th day of January, 1901, the Commissioner of Patents declared an interference between defendant's said application for registration and complainant's said registration No. 35,552, the subject-matter of said interference being a streak of distinctive color produced in or applied to wire rope as a trade-mark for wire rope, as will more fully and at large appear by a certified copy of the Commissioner's letter declaring said interference, which is herewith filed and marked "Exhibit E."

Seventh. Your orator further shows unto your honors that after said interference was declared proofs of great length were taken on behalf of both of the parties thereto (to-wit, the complainant and defendant in this cause, a printed copy of A. Leschen & Sons Rope Company's record, marked Exhibit F, and a printed copy of Broderick & Bascom Rope Company's record, marked Exhibit G, in said interference, being filed herewith) and the case was fully argued by both parties before the examiner of interferences in the United
4 States Patent Office, who, on or about the 14th day of January, 1903, decided that your orator was the first to adopt

and use said trade-mark and was entitled thereto, as will more fully and at large appear by a certified copy of the decision of the examiner of interferences herewith filed, and marked "Exhibit H:" That thereafter the defendant, The Broderick & Bascom Rope Company appealed from the decision of the examiner of interferences to the Commissioner of Patents, who on the 14th day of April 1903, affirmed the decision of the examiner of interferences and held that your orator was the first to adopt and use said trade-mark and was the owner thereof, as will more fully and at large appear by a certified copy of the decision and opinion of the Commissioner of Patents marked "Exhibit I," which is herewith filed.

Eighth. Your orator further shows unto your honors that notwithstanding the frequent and earnest protests by your orator and notwithstanding the said decisions by the examiner of interferences and the Commissioner of Patents, yet the defendant continues its unlawful use of said trade-mark and has declared its intention so to do until enjoined by the decree of this honorable court, all to the manifest wrong and injury to your orator, to whom said trade-mark is of great intrinsic worth, as designating throughout the United States and the Territories thereof and in foreign countries a popular and well-known wire rope made and sold by your orator and which is accepted and has for many years past been recognized as your orator's trade-mark, and as a token that the wire rope bearing said trade-mark is the genuine product of your orator's factory, and as designating the best quality and especially high grade rope of your orator the said trade-mark being accepted by the public as a guarantee of excellence and that the rope bearing said mark (eminated) from and had its origin with your orator, who was the first to adopt and use the same and who has continuously used said trade-mark since the year 1888, no other person, firm or corporation having the right to such use, all of which has been acquiesced in by the public, with the exception of this defendant, and by it only since early in the year 1900.

Ninth. Your orator further shows unto your honors that with intent to defraud your orator, to deceive the public and to take unfair and unlawful advantage of the reputation of your orator's wire ropes, justly acquired under said distinguishing mark, and with a fraudulent design of imposing upon the ultimate purchasers of said wire rope, and in defiance of your orator's rights and without its consent, the defendant, The Broderick & Bascom Rope Company has unlawfully made and sold wire rope having one strand of a distinctly different color from the other strands; that the use of said mark by the defendant has been calculated to and has deceived the public and that it was adopted and used by the defendant, as your orator verily believes, for the purpose of deceiving the public and procuring for the defendant sales of wire rope which would otherwise be made by your orator, and that said mark is being used by the defendant for the purpose of taking unfair advantage of the demand for your ora-

tor's said wire rope, which exists by reason of the many years' use of the trade-mark by your orator and the superiority of the wire rope to which said trade-mark has by your orator been applied, and the defendant has hereby been able to make sales on the strength of your orator's reputation, whose wire rope is known to the trade and to the ultimate purchasers by said mark and that your orator has been damaged thereby.

Tenth. Your orator further shows unto your honors that the defendant, by reason of its unlawful (similation) of said mark, and by reason of its fraudulent imitation of your orator's wire rope, has received and enjoyed and is receiving and enjoying great gains, profits and advantages, which might and otherwise would be obtained by your orator and to which your orator is entitled, but how much your orator does not know, and prays a discovery thereof. That the aforesaid unlawful acts have caused great damage to your orator exceeding the sum of fifty thousand dollars and unless prevented by this honorable court your orator fears that the defendant will continue said unlawful acts to the great and irreparable injury of your orator.

Eleventh. Your orator further shows unto your honors that the said trade-mark is used by your orator in commerce between the United States and foreign countries and particularly between the United States and Canada, Mexico, Yukon Territory, Prince Edward islands, British Colombia, Ontario, Nova Scotia, Cuba, Porto Rico, Colombia, South America, Brazil, Sandwich islands, Philippine islands, and India, and that it is also used, as your orator is informed and believes, by the defendant in commerce between the United States and foreign countries and particularly in commerce between the United States and Canada and Mexico.

In consideration whereof and inasmuch as your orator can have no adequate redress at law and is without complete remedy save by the aid and interposition of this court of equity, your orator respectfully prays:

6 I. That the defendant, The Broderick & Bascom Rope Company, its agents, servants attorneys and workmen be perpetually enjoined from using as a trade-mark for wire rope, one strand of a distinctive color from the other strands of the rope, or any colorable imitation thereof.

II. That your honors grant unto your orator in addition to a permanent injunction, a restraining order and an injunction *pendente lite* directed to said defendant, its agents, servants, attorneys and workmen enjoining it and them from using the said trade-mark or any such imitation thereof as may be calculated to deceive.

III. That the defendants be decreed to account for and pay to your orator the damages which your orator has sustained by reason of the defendant's infringement on its good will in business and of its said trade-mark as hereinbefore set forth, and that the defendant be decreed to pay to your orator the profits which it has derived from such infringement.

IV. That the defendant be decreed to pay the costs of this suit and that your orator may have such other and further relief as the nature of the case may require and to your honors may seem just.

May it please your honors to grant not only a writ of injunction conformable to the prayer of this bill, but also a writ or writs of subpœna issued out of this honorable court to be directed to the said Broderick & Bascom Rope Company commanding it on a certain day to be named therein, and under a certain penalty, in said writ to be inserted, to be and appear by its proper officers (befire) your honors in this court then and there to answer the premises and to abide by and perform such order and decree therein as to your honors may seem just and agreeable to equity and good conscience.

And your orator will ever pray &c.

A. LESCHEN & SONS ROPE CO.,
By HENRY LESCHEN, Pres't.

GEO. H. KNIGHT,
Sol'r for Comp't.

7–9 STATE OF MISSOURI, } ss:
City of St. Louis, }

Henry Leschen, being duly sworn doth depose and say that he is the president of the A. Leschen & Sons Rope Company, complainant in the foregoing bill, and that the same is true, except as to such matters as are stated to be based on information and belief and as to such matters he believes it to be true.

HENRY LESCHEN.

Sworn to and subscribed before me this 5th day of May, 1903. My term expires Feb. 8, 1907.

[SEAL.]

E. S. KNIGHT,
Notary Public.

11–12 United States Patent Office.

A. LESCHEN & SONS ROPE COMPANY, of St. Louis, Missouri.

Trade-Mark for Wire Rope.

Statement and Declaration of Trade-Mark No. 35,552, Registered December 4, 1900. Application Filed August 10, 1900.

Statement.

To all whom it may concern:

Be it known that the A. Leschen & Sons Rope Company, a corporation duly organized and existing under the laws of the State of Missouri, and located and doing business in the city of St. Louis, in

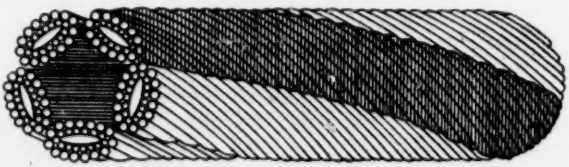
# TRADE-MARK.

No. 35,552. Registered Dec. 4, 1900.

**A. LESCHEN & SONS ROPE COMPANY.**

**WIRE ROPE.**

(Application filed Aug. 10, 1900.)



No. 187.
A L & S Rope Co } p. 10
B & B. Rope Co

attest:—
M. P. Smith
E. S. Knight

Proprietor:—
A. Leschen & Sons Rope Co
By Wright Bros
atty's.

said State, has adopted for its use a trade-mark for wire rope, of which the following is a full, clear, and exact description.

The trade-mark consists of a red or other distinctively-colored streak applied to or woven in a wire rope. The color of the streak may be varied at will, so long as it is distinctive from the color and body of the rope.

The essential feature of the trade-mark is the streak of distinctive color produced in or applied to a wire rope.

This mark is usually applied by painting one strand of the wire rope a distinctive color, usually red.

This mark is also used on letter-heads, circulars, &c., by a representation of a section of wire rope, one strand thereof being of a color distinctive from the other strands.

This trade mark has been continuously used in the business of said corporation since July 1, 1886.

The class of merchandise to which this trade-mark is appropriated is ropes, and the particular description of goods comprised in said class upon which the said mark is used is wire ropes. The distinctive color is usually incorporated in the goods in the manufacture thereof; but it may be displayed thereon by labels.

A. LESCHEN & SONS ROPE CO.
CHAS. H. TUCKER, Treasurer.

In presence of—
E. S. KNIGHT.
M. P. SMITH.

(Here follows diagram marked p. 10.)

Declaration.

STATE OF MISSOURI, } ss:
City of St. Louis, }

Charles H. Tucker, being duly sworn, deposes and says that he is treasurer of the corporation The A. Leschen & Sons Rope Company, the applicant named in the foregoing statement; that he verily believes that the foregoing statement is true; that the said corporation has, at this time, a right to the use of the trade-mark therein described; that no other person, firm or corporation has the right to such use either in the identical form, or in any such near resemblance thereto as might be calculated to deceive; that the trade mark is used by the said corporation in commerce between the United States and foreign nations or Indian tribes, and particularly with Canada and Mexico; and that the description and facsimile presented for record truly represent the trade-mark sought to be registered.

CHARLES H. TUCKER.

Subscribed and sworn to before me this 8th day of August, 1900. 1900.

[L. S.] E. S. KNIGHT,
Notary Public.

13 And afterwards, to-wit: on the 29th day of September, A. D. 1903, there was filed in said cause a demurrer to bill of complaint, which is in words and figures as follows, to-wit:

(Demurrer to Bill of Complaint.)

In the Circuit Court of the United States in and for the Eastern Division of the Eastern Judicial District of Missouri.

A. LESCHEN & SONS ROPE COMPANY, Complainant,
vs.
BRODERICK & BASCOM ROPE COMPANY, Defendant. } In Equity.

The Demurrer of the Above Named Defendant, Broderick & Bascom Rope Company, to the Bill of Complaint of the Above Named Complainant.

The defendant by protestation, not confessing or acknowledging all or any of the matters or things in the said bill of complaint contained to be true, in such manner and form as the same are therein set forth and alleged, doth demur to the said bill, leave to file said demurrer having first been obtained, and for cause of demurrer states:

That the alleged trade-mark relied on and set forth in the said bill and a copy of the registration of which (designated in said bill Exhibit "A") in the office of the Commissioner of Patents of the United States is attached to and a part of the said bill, is not a lawful and valid trade-mark, for that the said alleged trade-mark is not and was not susceptible of exclusive appropriation and use as a trade-mark, but that the same was at the date of its said registration and is *publici juris* and open to all.

Wherefore and for divers other good causes of demurrer appearing on the said bill, this defendant doth demur thereto, and it prays the judgment of this honorable court whether it shall be compelled to make any answer to the said bill and it humbly prays to be hence dismissed with its reasonable costs in this behalf sustained.

DAWSON & GARVIN,
Solicitors for said Defendant.

I hereby certify that the foregoing demurrer is in my opinion well founded in point of law.

JAS. P. DAWSON,
Of Counsel for Defendant.

14 UNITED STATES OF AMERICA,
Eastern Division of the Eastern Judicial District of Missouri, } *ss:*

John J. Broderick, being duly sworn, deposeth and saith: I am the president of the above named defendant. The foregoing demurrer is not interposed for delay.

JOHN J. BRODERICK.

Sworn to before me this 29th day of September, 1903.

[SEAL.] EDWIN W. MILLS,
Notary Public in and for the said City of St. Louis and State of Missouri, in said Division of said Judicial District of Missouri.

My term expires April 23rd, 1907.

And afterwards, to-wit: on the 23rd day of January, A. D. 1904, the following among other proceedings were had and appear of record in said cause, to-wit:

(Order Sustaining Demurrer to Bill).

A. LESCHEN & SONS ROPE COMPANY, Complainant,
*vs.*
BRODERICK & BASCOM ROPE COMPANY, Defendant. } 4852.

The court having duly considered the demurrer to the bill of complaint heretofore submitted herein, doth order that said demurrer be sustained.

ELMER B. ADAMS, Judge.

January 23, 1904.

And afterwards, to-wit: on the 21st day of March, A. D. 1904, the following further proceedings were had and appear of record in said cause, to-wit:

(Decree Dismissing Bill).

A. LESCHEN & SONS ROPE COMPANY, Complainant,
*vs.*
BRODERICK & BASCOM ROPE COMPANY, Defendant. } 4852.

The demurrer to the bill of complaint herein having been heretofore sustained by the court, and the said complainant declining to plead further, it is ordered, adjudged and decreed by the court, that the said bill be dismissed at complainant's costs, for which let execution issue.

ELMER B. ADAMS, Judge.

March 21, 1904.

15 And afterwards to-wit: on the 25th day of March, A. D. 1904, the following further proceedings were had and appear of record in said cause, to-wit:

(Order Granting Appeal, &c.)

A. LESCHEN & SONS ROPE COMPANY, Complainant,
*vs.*
BRODERICK & BASCOM ROPE COMPANY, Defendant. } 4852.

Now comes the complainant by its solicitors and files an assignment of errors and petition praying an appeal to the United States circuit court of appeals for the eighth circuit, from the decree rendered herein; and thereupon it is ordered

That said appeal be granted upon said complainant giving a bond for costs in the penal sum of five hundred dollars; thereupon complainant presents a cost bond which is approved by the court and filed and a citation, citing and admonishing said defendant to be and appear in said circuit court of appeals within sixty days from this date is signed by the judge.

It is further ordered that the clerk of this court make out and certify to the said circuit court of appeals a transcript of the record and proceedings in this cause.

ELMER B. ADAMS, Judge.

March 25, 1904.

Said assignment of errors, petition for appeal and bond, are respectively in words and figures as follows, to-wit:

(Assignment of Errors.)

United States Circuit Court of the Eastern District and Division of Missouri.

A. LESCHEN & SONS ROPE COMPANY
*vs.*
BRODERICK & BASCOM ROPE COMPANY. } No. 4852.

Appeal and Assignment of Errors.

And now comes the complainant by its solicitors and by leave of court in that behalf first obtained, takes this, its appeal, in the cause of the action aforesaid to the United States circuit court of appeals for the eighth judicial circuit, from the decree entered in this cause on or about the 21st day of March, 1904.

In support of said appeal and as reasons therefor said complainant assigns the following to wit:

16 First. That the court erred in finding that the complainant's registered trade-mark is not a good and valid trade-mark and registerable as such under the statutes of the United States for such cases made and provided.

Second. That the court erred in finding that complainant's trade-mark registration No. 35,552 dated December 4, 1900 is not a valid trade-mark entitling complainant to protection under the act of Congress of March 3, 1888.

Third. That the court erred in holding that complainant's registered trade-mark is not for an arbitrary shape or symbol and in finding that the mark consists of a description of the way the goods are made.

Fourth. That the court erred in holding that complainant's registered trade-mark is not such a mark as to be susceptible of exclusive appropriation under the established principles governing trade-marks at common law.

Fifth. That the court erred in holding that complainant's registered trade-mark is descriptive and therefore not a valid trade-mark.

Sixth. That the court erred in finding that complainant's registered trade-mark is descriptive of the character of the goods made and sold by complainant.

Seventh. That the court erred in holding that the complainant's registered trade-mark should have been limited to a strand or streak of a particular color different from the body of the rope.

Eighth. That the court erred in sustaining defendant's demurrer and dismissing complainant's bill.

JONES, JONES & HOCKER,
GEO. H. KNIGHT,
Sol'rs for Comp't.

March 25th, 1904.

United States Circuit Court of the Eastern District and Division of Missouri.

A. LESCHEN & SONS ROPE CO.
vs.
BRODERICK & BASCOM ROPE CO.
} No. 4852.

Petition for Appeal.

The above named complainant, A. Leschen & Sons Rope Company believing itself aggrieved by the final decree entered in
17 this cause on or about the 21st day of March, 1904, does hereby appeal from said decree to the United States circuit court of appeals for the eighth judicial district and prays that this, its appeal, may be allowed, and that a transcript of the proceedings and papers upon which said decree was made, duly authenticated, may be sent to the circuit court of appeals for the eighth judicial circuit.

JONES, JONES & HOCKER,
GEO. H. KNIGHT,
Solicitors for Complainant.

March 25th, 1904.

(Bond.)

Know all men by these presents, that we, the A. Leschen & Sons Rope Company, of St. Louis, Missouri, as principal and the Fidelity & Deposit Co. of Maryland as surety are held and firmly bound unto the Broderick & Bascom Rope Company, of St. Louis, Missouri, in the full and just sum of five hundred dollars to be paid to the said Broderick & Bascom Rope Company, its successors or assigns, to which payment well and truly to be made, we bind ourselves, our heirs, executors and administrators, jointly and severally, by these presents.

Sealed with our seals, and dated this 24th day of March, A. D. 1904.

Whereas, lately at the September term A. D. 1903, of the circuit court of the United States for the eastern division of the eastern judicial district of Missouri, in a suit depending in said court between the said A. Leschen & Sons Rope Company, complainant, and the said Broderick & Bascom Rope Company defendant, there was rendered against the said A. Leschen & Sons Rope Company a decree dismissing its bill of complaint, and the said A. Leschen & Sons Rope Company has obtained an appeal of the said court to reverse the decree in the aforesaid suit, and a citation directed to the said Broderick & Bascom Rope Company, citing and admonishing it to be and appear in the U. S. circuit court of appeals for the eighth circuit sixty days from and after the date of said citation.

Now the condition of the above obligation is such, that if the said

A. Leschen & Sons Rope Company shall prosecute said appeal
18 to effect, and answer all damages and costs if it fail to make good its appeal, then the above obligation to be void, else to remain in full force and virtue.

Sealed and delivered in presence of

A. LESCHEN & SONS ROPE CO., [SEAL.]
By HENRY LESCHEN, Pres't.
FIDELITY AND DEPOSIT COM- [SEAL.]
PANY OF MARYLAND,
[SEAL.] By ROB'T L. McLARAN,
Resident Vice-President.

Attest: C. J. McLARAN, Resident Assistant Secretary.

Approved by—
ELMER B. ADAMS, Judge.

And on said 25th day of March, A. D. 1904, there was filed in said cause a præcipe for transcript, which is in words and figures as follows, to-wit:

United States Circuit Court of the Eastern District and Division of Missouri.

A. LESCHEN & SONS ROPE COMPANY
*vs.*
BRODERICK & BASCOM ROPE COMPANY. } No. 4852.

Præcipe for Transcript.

The clerk of the court is hereby requested, in preparing the transcript of record for the appeal in this cause, to omit from said transcript everything on file in the case with the exception

1st. The bill of complaint and the exhibit thereto attached.

2nd. The demurrer to the bill of complaint.

3rd. The opinion of his honor, Judge Adams, sustaining the demurrer.

4th. The final decree dismissing the bill.

JONES, JONES & HOCKER,
GEO. H. KNIGHT,
Solicitor- for Complainant.
DAWSON & GARVIN,
Solicitor- for Defendant.

March 25th, 1904.

On January 23rd, 1904, there was filed in said cause an opinion on demurrer, which is in words and figures as follows, to-wit:

19 (Opinion on Demurrer.)

In the Circuit — of the United States for the Eastern Division of the Eastern District of Missouri.

A. LESCHEN & SONS ROPE COMPANY, Complainant,
vs.
BRODERICK & BASCOM ROPE COMPANY, Defendant.

ADAMS, district judge:

This is a demurrer to a bill seeking to enjoin the defendant from infringing a registered trade-mark. The facts disclosed by the bill, so far as is necessary for the present purposes are as follows:

On December 4, 1900, the complainant registered its mark in the United States Patent Office, pursuant to the provisions of the act of March 3, 1881, entitled: "An act to authorize the registration of trade-marks and protect the same," describing it in the declaration as follows:

"The trade-mark consists of a red or other distinctively colored streak applied to or woven in a wire rope. The color of the streak may be varied at will, so long as it is distinctive from the color of the body of the rope."

"The essential feature of the trade-mark is the streak of distinctive color produced in or applied to wire rope. This mark is usually applied by painting one strand of the wire rope a distinctive color,—usually red. This mark is also used on letter-heads, circulars, &c., by a representation of a section of wire rope, one strand thereof being of a color distictive from the other strands."

Accompanying this description appears a picture or drawing of a section of wire rope showing the streak as described in the declaration, extending throughout the length of the section.

Complainant and defendant both being citizens of this State as shown by the bill, the jurisdiction of this court is invoked solely on the ground that a Federal question is involved, namely; a right acquired under the provisions of the act of March 3, 1881, *supra.* (21 Stat., 502).

Such being the facts unless complainant has a valid trade-mark as registered, this court has no jurisdiction of the case. Luyties vs. Hollendeer, 30 Fed., 632; Illinois Watch Case Co. vs. Elgin Nat'l Watch Co., 94 Fed., 667; Elgin Nat'l Watch Co. vs. Illinois Watch Case Co., 179 U. S., 665.

If the mark as registered is invalid the bill cannot be helped by the general allegation of unfair competition. This case is
20 therefore limited to the inquiry whether the complainant by registering its mark secured a right thereto which entitles it to protection under the act of Congress above referred to.

By the first section of the act of 1881, any person may obtain registration of his trade-mark by complying with certain require-

ments, among them by causing to be recorded in the Patent Office a statement or declaration containing "a description of the trade-mark itself with fac similes thereof, and a statement of the mode in which the same is applied and affixed to goods" etc. This description and fac simile of the mark presented for registry must in the language of the act "truly represent the trade-mark sought to be registered."

Pursuant to this statutory requirement the complainant described his mark as consisting of "a red or other distinctive colored streak applied to or woven in a wire rope," with the reservation of the right to vary the streak of color at will, provided that it be distinctive from the color of the body of the rope.

The description when read in its entirety obviously means as was conceded in argument that the mark claimed by complainant consists of a constituent part or portion of the merchandise itself, extending throughout its entire length and integral with its substance.

It is not an arbitrary form, shape or symbol attached to packages containing the goods as is the usual custom, but it consists rather of a description of the way the goods are made and particularly of the color which the proprietor gives them. The fac simile shown in the application for the trade-mark is a picture of a section of the goods themselves as made by the proprietor, with a suggestion of a streak of color along its length.

I cannot escape the conviction at the out-set that the mark claimed by complainant is obnoxious to the first principles of the law governing the acquisition of a valid trade-mark. It is well settled that registration under the act of 1881 cannot make the adopted mark a valid trade-mark, unless it was susceptible of exclusive appropriation under the established principles governing trade-marks at common law. Elgin Nat'l Watch Co. vs. Illinois Watch Case Co., *supra*.

At common law the mark must be some symbol or device not descriptive of the character, quality or composition of an article, or the place where it is manufactured, but such a thing as indicates origin or ownership of the goods. Canal Company vs. Clark, 13 Wall., 311; Brown Chemical Company vs. Meyer, 139 U. S., 21 540; Macmahan Pharmacal Co. vs. Denver Chemical Mfg. Co., 113 Fed., 468.

How can [anythi*gn*] be more descriptive of complainant's merchandise than to say; in substance: My rope is made with a streak of color running longitudinally through it, applied to or woven into it?

And how can anything be more descriptive of the character of the goods themselves than a picture of a section of the rope as made by complainant? One might as well say that a manufacturer of chairs can adopt the diagram of a chair, or that a watch-maker can adopt the diagram of a watch, or a stove-maker the diagram of a stove, unaccompanied by any surrounding form, figure, symbol or display, as his trade-mark.

It certainly cannot be contended that a watchmaker can monopo-

lize a picture of the watch with no accompanying form or symbol to denote his particular manufacture, when thousands of other persons are making and dealing in the same article. If this is true, is he relieved by tinting the watch or some part of it with some one of the [primatic] or primary colors, and adopting a picture of such tinted or colored article (without more) as his trade-mark? In other words can the complainant apply to or weave into his rope a [stead] of any color which his judgment or caprice may at any time [distate], (for it is to be observed that complainant's description of his mark is: "a red or other distinctive colored streak applied to or woven in a wire rope," with the privilege of varying from one color to another color at will) and thereby secure a monopoly of that method of manufacture the well known product?

It seems to me that the question answers itself. If it may do so, it can appropriate any and all of the primary colors, provided only they be different from the color of the body of the rope and may make use of any color today, and another color to-morrow, and still another color at another time and so on.

This permissible shifting of the most striking feature of the mark from time to time is in itself fatal to its validity. The fundamental purpose of the trade-mark is to indicate on sight the ownership or origin of the goods to which it is applied. It must therefore be permanent, the same today, to-morrow and at all times,—otherwise its legitimate purposes cannot be subserved, and the public may readily be deceived.

22 The conclusion already indicated is supported by abundant authority. But before considering the authorities it is well to again refer to the fact that no form, figure or symbol independently of the goods themselves is adopted by complainant in connection with the streak of color claimed as its trade-mark, and the "streak" itself is not of any prescribed width, shape or direction. It may be as counsel said in argument, a narrow or wide streak of paint affixed externally and in a straight or irregular line along the length of the rope or it may be a colored thread of wire running with the twist of the rope and forming a part of it.

It is held in the case of Fairbanks vs. Jacobus, 14 Blatch. 337, 341, that a valid trade-mark must be "something" different from the article itself which the mark designates." The case is strongly illustrative of the conclusion reached in this case.

In the case of Fleischmann vs. Starkey, 25 Fed. 127, Judge Colt says: "Color often serves as the ground work of a trade-mark, and it may be a very essential element in its composition. * * * "But the term 'mark' implies form rather than color, and it consists of some peculiar name, symbol, figure, letter, or device whereby one manufacturer distinguishes his goods from like goods sold by other persons." * * * "Color of a label apart from a name or device can hardly be the subject of a trade-mark."

Judge Coxe in Philadelphia Novelty Mfg. Co. vs. Rouss, 40 Fed. 87, says: "The trend of the law is strongly towards the proposition

that, in ordinary circumstances, the adoption of packages of peculiar form and color alone, unaccompanied by any distinguishing symbol, letter, sign, or seal, is not sufficient to constitute a trade-mark." * * * "The courts will have time for little else, if they undertake to meddle with and regulate the color and size of the wrapping paper and boxes in which a shop-keeper displays his wares. Trade should not be hampered by vexatious restrictions in matters, apparently so trivial."

Brown on Trade-Marks, 2nd ed., sec. 269, lays down the rule thus: "Form is necessary to make color an essential element in a trade-mark. In other words, color alone cannot legally be deemed an arbitrary symbol. That form may be a geometrical figure, or a representation of an object having a fixed, definite shape and being susceptible of description: Thus, a circle, a square, a triangle; or an arrow, or an anchor or a monogram; or any of an indefinite variety of objects in nature or art which may be easily described and readily apprehended. But nothing short of this requirement could be
23 sufficient. * * * "We can describe and recognize a Maltese cross, a diamond within a circle, a five pointed star, a flag of fixed proportions having a certain number of stripes and stars, or national emblems. Then color may well be a valid essential constituent, but it is hardly within the range of possibility to convey an adequate idea of a thing which has no fixed invariable limits."

In the case *In re* Handsous Trade-Mark, 37 Chancery, division 112, the supreme court of judicature in construing the English statute which requires a trade-mark to be distinctive in order to be valid makes use of the following language: "This is the argument as I understand it. It is the plain intention of the act, that where the distinction of the mark depends upon color, that will not do. You may register a mark which is otherwise distinctive, in color, and that gives you the right to use it in any color you like; but you cannot register a mark of which the only distinction is the use of a color, because practically under the terms of the act, that would give you a monopoly of all the colors of the rainbow."

In the recent unreported case of Dodge Manufacturing Company vs. Sewall & Day Cordage Company, decided by Lowell, judge in the circuit court of the district of Massachusetts, a very similar question to that now under consideration was considered. The complainant there sought to enjoin the defendant from an alleged infringement of a registered trade-mark. In that case as in this, the class of merchandise to which the trade-mark related was rope especially made for the transmission of power. It is true that the court in that case found there was no infringment, but in its opinion it took occasion to say as follows:

"To allow the complainant the exclusive right of twisting into rope threads of any and all colors would give it a monopoly of the only practical way of marking rope. Where the trade-mark is a figure or design the owner's right may well cover that figure or design repro-

duced in any color, for the identity of the figure may mis-lead the purchaser in spite of the difference of color."

The foregoing cases and many others found cited in them, in my opinion, sustain the proposion that a trade-mark consisting of one of the primary colors only, is not valid, much more must this
24 be true when the mark claimed by the complainant in this case, by its terms and description covers the use of any and all of the colors, and not limited to any of them.

The demurrer to the bill must be sustained.

GEORGE H. KNIGHT,
Solicitor for Complainant.
DAWSON & GARVIN,
HIGDON & LONGAN & HOPKINS,
Solicitors for Defendant.

Opinion rendered January 23, 1904.

UNITED STATES OF AMERICA,
Eastern Division of the Eastern Judicial District of Missouri, } ss:

I, James R. Gray, clerk of the circuit court of the United States, in and for the eastern division of the eastern judicial district of Missouri, do hereby certify the writing hereto attached to be a full, true and complete transcript of the record and proceedings in case No. 4852 of A. Leschen & Sons Rope Company complainant, against Broderick & Bascom Rope Company, defendant, as fully as the same remain on file and of record in said case in my office, except such portions thereof as are omitted in conformity with the præcipe filed in said cause; and that the original citation is hereto attached and herewith returned.

Seal of the United States Circuit Court Eastern Division of the Eastern Judicial District Missouri.

In witness whereof, I hereunto subscribe my name and affix the seal of said court, at office in the city of St. Louis, in the eastern division of said district, this 26th day of March in the year of our Lord nineteen hundred and four.

JAMES R. GRAY,
Clerk of said Court,
By W. J. COURTNEY, Deputy.

Filed Mar. 26, 1904.
JOHN D. JORDAN, Clerk.

No. 4852. United States circuit court, eastern division of the eastern judicial district of Missouri. A. Leschen & Sons Rope Co. against Broderick & Bascom Rope Co. Duly certified transcript of the record and proceedings in the above entitled cause.

25 (Appearance for Appellant.)

On the thirtieth day of March, A. D. 1904, the appearance of counsel for the appellant was filed in the clerk's office of said circuit court of appeals in said cause, in the words and figures following, to-wit:

United States Circuit Court of Appeals, Eighth Circuit.

A. LESCHEN & SONS ROPE COMPANY, Appellant,
*vs.*
BRODERICK & BASCOM ROPE COMPANY. } No. 2055.

The clerk will enter our appearance as counsel for the appellant

JAS. C. JONES.
GEO. H. KNIGHT.

(Endorsed:) U. S. circuit court of appeals, eighth circuit. No. 2055. A. Leschen & Sons Rope Company, appellant, *vs.* Broderick & Bascom Rope Company. Appearance. Filed Mar. 30, 1904. John D. Jordan, clerk. James C. Jones, George H. Knight, counsel for appellant.

(Appearance for Appellee.)

And on the sixteenth day of April, A. D. 1904, the appearance of counsel for appellee was filed in the clerk's office of said circuit court of appeals in said cause, in the words and figures following, to-wit:

United States Circuit Court of Appeals, Eighth Circuit.

A. LESCHEN & SONS ROPE COMPANY, Appellant,
*vs.*
BRODERICK & BASCOM ROPE COMPANY. } No. 2055.

The clerk will enter my appearance as counsel for the appellee.

JAS. P. DAWSON,
Solicitor for Appellee.

26 (Endorsed:) U. S. circuit court of appeals, eighth circuit. No. 2055. A. Leschen & Sons Rope Co., appellant, *vs.* Broderick & Bascom Rope Company. Appearance. Filed Apr. 16, 1904, John D. Jordan, clerk. James P. Dawson, counsel for appellee.

(Order of Submission.)

And on the twenty-fifth day of May, A. D. 1904, in the record of the proceedings of said circuit court of appeals is an order of submission in said cause, in the words and figures following, to-wit:

United States Circuit Court of Appeals, Eighth Circuit, May Term, 1904.

WEDNESDAY, May 25, 1904.

A. LESCHEN AND SONS ROPE COMPANY, Appellant,
*vs.*
BRODERICK AND BASCOM ROPE COMPANY. } No. 2055.

Appeal from the Circuit Court of the United States for the Eastern District of Missouri.

This cause having been called for hearing in its regular order, argument was commenced by Mr. George H. Knight for appellant, continued by Mr. James P. Dawson for appellee and concluded by Mr. James C. Jones for appellant.

Thereupon, this cause was submitted to the court on the transcript of record from said circuit court and the briefs of counsel filed herein.

(Opinion.)

And on the twenty-fourth day of December, A. D. 1904, an opinion of said circuit court of appeals was filed in said cause, in the words and figures following, to-wit:

27 United States Circuit Court of Appeals, Eighth Circuit, December Term, A. D. 1904.

A. LESCHEN & SONS ROPE COMPANY, Appellant,
*vs.*
BRODERICK & BASCOM ROPE COMPANY, Appellee. } No. 2055. Appeal from the Circuit Court of the United States for the Eastern District of Missouri.

Mr. George H. Knight and Mr. James C. Jones for appellant.

Mr. James P. Dawson (Messrs. Dawson & Garvin were with him on the brief) for appellee.

Before Sanborn and Van Devanter, Circuit Judges, and Amidon, District Judge.

AMIDON, district judge, delivered the opinion of the court:

Both complainant and defendant are corporations organized under the laws of the State of Missouri and are engaged in manufacturing wire rope in that State. The complainant has registered a trademark under the act of March 3, 1881, which it claims the exclusive right to use as indicative of its manufacture. In its statement filed with the Commissioner of Patents, it describes its trademark as fol-

lows: "The trademark consists of a red or other distinctively colored streak applied to or woven in a wire rope. The color of the streak may be varied at will so long as it is distinctive from the color of the body of the rope. The essential feature of the trademark is the streak of distinctive color produced in or applied to a wire rope. This mark is usually applied by painting one strand of the wire rope a distinctive color, usually red." The appellant, who was complainant below, filed its bill to restrain the defendant from infringing this trademark. The trial court sustained a demurrer and dismissed the bill.

Much is said in the brief of appellant to the effect that the defendant has been guilty of unfair trade competition by palming off on the public ropes of its manufacture as complainant's rope. This is a subject, however, over which the Federal courts have no jurisdiction. Complainant and defendant are both citizens of the same State and for this reason jurisdiction is confined to the trade-
28 mark as registered. If that mark is invalid, the Federal courts are without authority to grant any relief on the ground of unfair trade competition. Illinois Watch Co. *vs.* Elgin National Watch Co., 179 U. S. 665.

Is, then, the trademark as registered a valid trademark? We do not think it is. Throughout their brief counsel for appellant refer to its trademark as a "strand of a wire rope of a distinctively different color from the other five strands of the rope." That is not, however, the trademark claimed in the statement as filed. The court has no power to make such a restriction. It is the registration and not the manufacture which controls the Federal courts in determining the validity of a trademark when plaintiff and defendant are citizens of the same State. If the statement is so general as to render the mark described invalid as a trademark, the court cannot sustain a more restricted mark which the claimant actually uses in his manufacture. "The plaintiffs have not restricted themselves to any particular description of goods comprised in such class. Their registration must stand or fall as a whole, for that to which they declare, in their registration, they intend to appropriate it. There is no provision in regard to trademarks such as there has been and is in regard to patents for inventions, that a suit may be maintained where the grant is valid as to a part but not as to the whole." Smith *vs.* Reynolds, Fed. Cases 13098, p. 638. (Blatchford, J.)

Furthermore, we do not think that a mark which consists simply in a colored strand in a wire rope but is not restricted to any particular color can be sustained as a valid trademark. In such a case it is the color which constitutes the mark and not its configuration, and a right to vary the color indefinitely would destroy that distinctive character which must inhere in a valid trademark. This was the holding of Judge Lowell in the case of Dodge Mfg. Co. *vs.* Sewell & Day Cordage Co., in the circuit court for the district of Massachusetts, decided July 5, 1898, but not reported. That case

involved the manufacture of ordinary hemp rope. The trademark described in the statement was as follows: "The general feature of said trademark is a colored thread contrasting with the color of the rope and twisted in the strands of the rope and periodically visible along the rope." Of this trademark Judge Lowell said: "A colored thread of some sort twisted in the rope is evidently almost or quite the only possible way of marking or identifying the rope itself, and it is in evidence that a colored thread has been commonly used for many years for such a purpose, though seldom if ever has it been used as a mark of origin. The defendant at one time twisted a blue thread into each strand of the transmission rope which it manufactured, but upon notification by the complainant that confusion might arise it ceased to do so at once and has since used red threads instead. If the complainant has any trademark, it is plainly confined to blue thread, for that is the only mark the complainant ever used. To allow the complainant the exclusive right of twisting into rope threads of any and all colors would give it a monopoly of the only practicable way of marking rope. Where a trademark is a figure or design, the owner's right may well cover that figure
29 or design reproduced in any color, for the identity of figure may mislead the purchaser in spite of the difference of color. In this case, the defendant's red thread will emphasize the difference between its rope and the complainant's blue thread rope and cannot deceive anybody." An injunction was refused to restrain the defendant from continuing to use the red thread in its manufacture.

A more serious defect, however, in the complainant's trademark here arises from the fact that the mark is not confined to a colored strand of the rope. It is described throughout the statement as a "streak." This term is wholly indefinite. A streak might be a straight line running lengthwise of the rope; it might run as circles around the rope; or it might run in spirals as is indicated by the picture of a section of the rope which accompanies complainant's statement. There is no claim that complainants in their manufacture ever ranged through the various forms and colors covered by their statement as filed. It is quite likely that they have confined themselves to a distinctive color of one of the several strands of the rope. This, however, is not the language in which their claim is embodied in the statement filed with the Commissioner of Patents and the court is compelled to look to that statement rather than to the manufacture, for we are not here dealing with a common law trademark based upon use; but a trademark claimed and described in a written statement. A trademark to be valid must be as distinctive and individual as a signature. The trademark claimed by the complainant has neither individuality of form nor of color. It may take any of several different forms and each of these forms may be presented in at least all the seven primary colors. The decision of the lower court is affirmed.

Filed December 24, 1904.

30 (Decree.)

And on the twenty-fourth day of December, A. D. 1904, in the record of the proceedings of said circuit court of appeals is a decree in said cause, in the words and figures following, to-wit:

United States Circuit Court of Appeals, Eighth Circuit, December Term, 1904.

SATURDAY, December 24, 1904.

A. LESCHEN AND SONS ROPE COMPANY, Appellant,
*vs.*
BRODERICK AND BASCOM ROPE COMPANY. } No. 2055.

Appeal from the Circuit Court of the United States for the Eastern District of Missouri.

This cause came on to be heard on the transcript of the record from the circuit court of the United States for the eastern district of Missouri, and was argued by counsel.

On consideration whereof, it is now here ordered, adjudged and decreed by this court, that the decree of the said circuit court, in this cause, be, and the same is hereby, affirmed with costs; and that the Broderick and Bascom Rope Company have and recover against the A. Leschen and Sons Rope Company the sum of twenty dollars for its costs herein and have execution therefor.

December 24, 1904.

(Petition for Appeal.)

And on the sixth day of February, A. D. 1905, a petition for appeal was filed in the clerk's office of said circuit court of appeals in said cause, in the words and figures following, to-wit:

In the United States Circuit Court of Appeals, Eighth Circuit, December Term, 1904.

A. LESCHEN & SONS ROPE COMPANY, Appellant,
*vs.*
BRODERICK & BASCOM ROPE COMPANY, Appellee. } In Chancery. No. 2055.

31 Petition for Appeal.

The A. Leschen & Sons Rope Company, appellant in the above entitled cause, considering itself aggrieved by the judgment and order entered herein on the 24th day of December, 1904, hereby ap-

peals from said judgment and order and the whole thereof to the Supreme Court of the United States.

JAMES C. JONES,
GEO. H. KNIGHT,
Solicitors and Counsel for A. Leschen & Sons Rope Company.

(Endorsed:) In chancery. No. 2055. United States circuit court of appeals eighth circuit. A. Leschen & Sons Rope Company, appellant, *vs.* Broderick & Bascom Rope Company, appellee. Petition for appeal. Filed Feb. 6, 1905, John D. Jordan, clerk.

(Assignment of Errors.)

And on the sixth day of February, A. D. 1905, an assignment of errors was filed in the clerk's office of said circuit court of appeals in said cause, in the words and figures following, to-wit:

In the United States Circuit Court of Appeals, Eighth Circuit, December Term, 1904.

| | | |
|---|---|---|
| A. LESCHEN & SONS ROPE COMPANY, Appellant, *vs.* BRODERICK & BASCOM ROPE COMPANY, Appellee. | } | In Chancery. No. 2055. |

Assignment of Errors.

Now comes the A. Leschen & Sons Rope Company, appellant in the above entitled cause, by George H. Knight and James C. Jones, its solicitors and counsel, and says that in the record of the proceedings in the above entitled cause, there is manifest error in this, to-wit:

1. The United States circuit court of appeals for the eighth circuit erred in ordering the circuit court to dismiss the bill of
32 complaint in this cause.

2. The United States circuit court of appeals for the eighth circuit erred in holding that the appellant's trade-mark as registered is not a valid trade-mark.

3. The United States circuit court of appeals for the eighth circuit erred in holding that it is the registration and not the manufacture which controls the Federal court in determining the validity of a trade-mark, when the complainant and defendant are citizens of the same State.

4. The United States circuit court of appeals for the eighth circuit erred in holding that the appellant's registration of its trade-mark was so general as to render the trade-mark described invalid.

5. The United States circuit court of appeals for the eighth circuit erred in holding that a mark which consists of a colored strand in a wire rope and not restricted to any color, could not be sustained as a valid trade-mark.

6. The United States circuit court of appeals for the eighth circuit erred in holding that it is the color which constitutes the mark and not its configuration.

7. The United States circuit court of appeals for the eighth circuit erred in holding that the appellant's trade-mark was defective because the mark was not confined to a colored strand of the rope, and because it is described in the statement as a streak, and in holding that said term is indefinite.

8. The United States circuit court of appeals for the eighth circuit erred in construing the appellant's trade-mark by one clause in the description without regard to the other parts of the claim and the accompanying illustration.

9. The United States circuit court of appeals for the eighth circuit erred in holding that appellant's trade-mark has neither individuality of form nor color.

10. The United States circuit court of appeals for the eighth circuit erred in holding that the appellant's trade-mark was not a good and valid trade-mark under the statute.

11. The United States circuit court of appeals for the eighth circuit erred in holding that it could not consider the allegations
33 made in the bill with respect to unfair competition in trade.

12. The United States circuit court of appeals for the eighth circuit erred in holding that appellant's registered trade-mark should have been limited to a strand or streak of particular color different from the body of the rope.

A. LESCHEN & SONS ROPE COMPANY,
By JAMES C. JONES,
GEO. H. KNIGHT,
Solicitors and Counsel for Appellant.

(Endorsed:) In chancery. No. 2055. United States circuit court of appeals eighth circuit. A. Leschen & Sons Rope Company, *vs.* Broderick & Bascom Rope Company. Assignment of errors. Filed Feb. 6, 1905, John D. Jordan, clerk.

(Bond on Appeal.)

And on the sixth day of February, A. D. 1905, a bond on appeal was filed in the clerk's office of said circuit court of appeals in said cause, in the words and figures following, to-wit:

## Bond.

Know all men by these presents, that the A. Leschen & Sons Rope Company, as principal, and the Fidelity & Deposit Company of Maryland, as surety, are held and firmly bound unto Broderick & Bascom Rope Company, in the full and just sum of five hundred dollars to be paid to the said Broderick & Bascom Rope Company, its certain attorney, successor or assign; to which payment well and truly to be made, we bind ourselves, our successors and assigns, jointly and severally by these presents.

Sealed and dated this 30th day of January, 1905.

Whereas, lately at a hearing of the United States circuit court of appeals for the eighth circuit, in a suit pending in said court between The A. Leschen & Sons Rope Company, appellant, and The Broderick & Bascom Rope Company, appellee, a decision was rendered against the said A. Leschen & Sons Rope Company,
34 and the said A. Leschen & Sons Rope Company having obtained leave to file an appeal and having filed a copy thereof in the clerk's office of the Supreme Court and the United States circuit court of appeals to reverse the decision of said aforesaid suit, and a citation directed to the said Broderick & Bascom Rope Company, citing and admonishing it to appear at the Supreme Court of the United States to be holden at Washington on the — day of —— 1905.

Now, the condition of the above obligation is such that if the said A. Leschen & Sons Rope Company shall prosecute its appeal to effect and answer all damages and *and* costs if it shall fail to make its plea good, then the above obligation to be void, otherwise to remain in full force and effect.

[SEAL.] A. LESCHEN & SONS ROPE COMPANY.
By HENRY LESCHEN, President.

Attest: CHAS. A. TUCKER.

[SEAL.] FIDELITY & DEPOSIT COMPANY OF MARYLAND,
By ROB'T L. McLARAN,
Resident Vice-President.

Attest: C. J. McLARAN,
Resident Assistant Sec'y.

Approved:
WALTER H. SANBORN,
Presiding Judge United States Circuit
Court of Appeals, Eighth Circuit.

(Endorsed:) In chancery. No. 2055. United States circuit court of appeals eighth circuit. A. Leschen & Sons Rope Company, *vs.* Broderick & Bascom Rope Company. Appeal bond. Filed Feb. 6, 1905, John D. Jordan, clerk.

(Order Allowing Appeal.)

And on the sixth day of February, A. D. 1905, in the record of the proceedings of said circuit court of appeals is an order allowing an appeal in said cause in the words and figures following, to-wit:

35 United States Circuit Court of Appeals, Eighth Circuit, December Term, 1904.

MONDAY, February 6. 1905.

A. LESCHEN & SONS ROPE COMPANY, Appellant,
*vs.*
BRODERICK & BASCOM ROPE COMPANY. } No. 2055.

Appeal from the Circuit Court of the United States for the Eastern District of Missouri.

Now comes the appellant by its counsel and presents to the cour its assignment of errors and petition for appeal to the Supreme Court of the United States in this cause;

Upon consideration whereof, it is now here ordered that such appeal be allowed conditioned upon the appellant giving a bond in the penal sum of five hundred dollars.

February 6, 1905.

(Citation.)

And on the tenth day of February, A. D. 1905, a citation was filed in the clerk's office of said circuit court of appeals in said cause, the original of which, with the acknowledgment of service endorsed thereon, is hereto attached and herewith returned.

36 The United States of America to Broderick & Bascom Rope Company, Greeting:

You are hereby cited and admonished to be and appear in the Supreme Court of the United States, at the city of Washington, D. C., thirty days from and after the day this citation bears date, pursuant to an appeal filed in the clerk's office of the United States circuit court of appeals for the eighth circuit wherein A. Leschen & Sons Rope Company is appellant and you are appellee, to show cause, if any there be, why the decree rendered against the said appellant, as in said appeal mentioned, should not be corrected, and why speedy justice should not be done the parties in that behalf.

Witness, the Honorable Walter H. Sanborn, presiding judge of the United States circuit court of appeals for the eighth circuit this

sixth day of February in the year of our Lord one thousand nine hundred and five.

WALTER H. SANBORN,
Presiding Judge of the United States Circuit
Court of Appeals for the Eighth Circuit.

Service of the above citation acknowledged this 8th day of February, 1905.

BRODERICK & BASCOM ROPE CO., Appellee,
By JAS. P. DAWSON, Its Solicitor.

[Endorsed:] No. — United States Supreme Court. A. Leschen and Sons Rope Company, appellant, *vs.* Broderick and Bascom Rope Company. Citation on appeal. Filed Feb. 10 1905 John D. Jordan clerk.

37 (Clerk's Certificate.)

United States Circuit Court of Appeals, Eighth Circuit.

I, John D. Jordan, clerk of the United States circuit court of appeals for the eighth circuit, do hereby certify that the foregoing thirty-seven pages contain full, true and complete copies of all the pleadings, proceedings, and record entries, including the opinion of said circuit court of appeals, in a certain cause wherein The A. Leschen and Sons Rope Company was appellant, and The Broderick and Bascom Rope Company was appellee, No. 2055, December term, 1904, as full, true and complete as the same remain on file and of record in my office.

I do further certify that the original citation, with the acknowledgment of service endorsed thereon, is hereto attached and herewith returned.

In testimony whereof, I hereunto subscribe my name and affix the seal of said circuit court of appeals, at office in the city of St. Louis, Missouri, in the eighth circuit, this twenty-eighth day of February, A. D. 1905.

[Seal United States Circuit Court of Appeals, Eighth Circuit.]

JOHN D. JORDAN,
Clerk of the United States Circuit Court
of Appeals for the Eighth Circuit.

Endorsed on cover: File No. 19,646. U. S. circuit court of appeals, 8th circuit. Term No. 187. A. Leschen & Sons Rope Company, appellant, *vs.* Broderick & Bascom Rope Company. Filed March 6th, 1905. File No. 19,646.

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# Supreme Court of the United States

OCTOBER TERM, 1905.

No. 187.

A. LEECHEN & SONS ROPE COMPANY,
*Appellant,*
*vs.*
BRODERICK & BASCOM ROPE COMPANY,
*Appellee.*

# BRIEF FOR APPELLANT

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*Counsel for Appellant.*

PRESS OF W. F. ROBERTS CO., WASHINGTON

# Supreme Court of the United States

**OCTOBER TERM, 1905.**

**No. 187.**

A. LESCHEN & SONS ROPE COMPANY,
*Appellant,*
*vs.*
BRODERICK & BASCOM ROPE COMPANY,
*Appellee.*

APPEAL FROM THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE EIGHTH CIRCUIT.

## STATEMENT OF CASE.

This is a suit in equity brought by A. L. Leschen & Sons Rope Company, a Missouri corporation, against Broderick & Bascom Rope Company, another Missouri corporation, for infringement of a Trade Mark for Wire Rope, registered under the Act of Congress of March 3, 1881.

The bill of complaint was filed May 8, 1903, in the Circuit Court of the United States for the Eastern Division of the Eastern District of Missouri (p. 2). The defendant demurred on the ground that the trade mark set up in the bill was not a lawful and valid trade mark (p. 8). The demurrer was allowed (p. 9) and, the complainant declining to plead further, the bill was dismissed (p. 10). From the decree of dismissal an appeal was taken to the United States Circuit Court of Ap-

peals for the Eighth Circuit (p. 10) and the latter court, on December 24, 1904, affirmed the decree of the circuit court (p. 23).

From the decree of the Circuit Court of Appeals the present appeal was duly taken (p. 27) and the cause is now in this court for review.

## Assignment of Errors.

Although various assignments of error appear in the record (p. 24) they all have for their object the bringing up for review by this court the fundamental, underlying question of the validity of the trade mark set out in the complainant's bill of complaint.

## Argument.

I. Attempts made to define what a trade mark is have usually been open to the criticism of narrowness. Browne on Trade Marks, 2nd Edition, p. 98, Sec. 85, has this to say:

> "The French have probably given this subject as keen and thoughtful study as any jurists in the world; and yet in the report of the Commission to examine the project which crystallized into their legislative act of the 23rd of June 1857, it is said:
>
> 'In what do marks consist? The plan of the law, avoiding the peril of a definition and leaving to doctrine and to jurisprudence the task of defining, has remained mute in this respect.'

The Council of State concurred in this idea of the impolicy of attempting an exact enunciation of the elements which constitute this thing, and said:

> 'The mark is any sign by means of which commerce distinguishes the products of one's manufacture, or the objects of his commerce.' "

In Elgin Watch Co. v. Illinois Watch Co. 179, U. S. 665, which was a case involving a trade mark registered under the very Act of March 3, 1881, under which the trade mark here in suit was registered, the present learned Chief Justice, speaking for this Court, said:—

> "Trade marks are not defined by the Act, which assumes their existence and ownership, and provides for a verified declaration by applicants for registration, that they have the exclusive right to the particular trade mark sought to be registered.
>
> "The term has been in use from a very early date, and, generally speaking, means a distinctive mark of authenticity, through which the products of particular manufacturers or the vendible commodities of particular merchants may be distinguished from those of others."

This definition, because of its breadth and scope and inclusiveness, seems to leave nothing to be desired, and we adopt it as the most satisfying of the scores to be found in the cases and in the text books.

II. Ever since its incorporation in the year 1886, the complainant company has been engaged in the manufacture and sale of wire ropes or cables. It is, therefore, a "particular manufacturer" as well "as a particular merchant," within the learned Chief Justice's definition.

In the year 1888, or about eighteen years ago, the Complainant adopted for its use and applied to its highest and best grade of wire rope or, in other words, to its manufactured "products," its "vendible commodities," so that said "products" and "vendible commodities might be distinguished from those of others" and bear a "distinctive mark of authenticity," a streak or stripe of contrasting color, usually red, laid upon one of the strands of each rope made by it.

As all the strands of a wire rope run spirally about its central core the effect of thus laying a stripe of color upon one individual strand was to give a definite, characteristic appearance to that particular strand and to cause it, by contrast with its fellows of different appearance, to stand out prominently as a distinctive spiral streak, which served, as a trade mark, readily identifying and distinguishing complainant's wire rope from the wire rope put out by all other manufacturers.

The spiral line of contrasting color thus applied was and is intended as and for a trade mark and for no other purpose. It serves no other purpose. It adds nothing to the strength or durability of the rope. It performs no mechanical function whatever. Nor is it applied for its beauty or aesthetical effect. It is essentially fugitive in character being worn off in the use of the rope.

The expense of applying this characteristic mark to the rope and of advertising it as complainant's trade mark, is considerable, yet so thoroughly does the mark distinguish complainants product from that of others that this expense is fully justified.

The bill avers that upwards of eight million feet of wire rope marked and identified in this way have been made and sold by complainant (p. 3); that such marking has come to identify complainant's rope throughout the United States and in foreign countries; and that all, save the defendant company, have recognized complainant's right to said mark and have acquiesced in complainant's rights therein and thereto. (p.4)

The demurrer, of course, admits all this to be true.

III. The next question, and apparently the crucial one, from the standpoint of the courts below, is: Were

the steps taken by complainant to register its mark under the Act of March 3, 1881, sufficient to secure to it the right to invoke the aid of the Federal Courts in the vindication of its mark as against infringers of it?

Let it be remembered, that registration under the Act of Congress creates no right of trade mark whatever. It simply confers the privilege of suing in the Federal Courts in case the registered mark is infringed by another engaged in commerce with foreign nations or Indian tribes.

Again referring to the opinion of the learned Chief Justice, in the Elgin case, (supra):

> "Trademarks are not defined by the Act, *which assumes their existence,* and ownership, and provides for a verified declaration by applicants for registration, that they have the exclusive right to the particular trade mark sought to be registered."

No right of trade mark being then created by the Act, the precise point to be determined in this particular case is simply this: Did the complainant in asking for registration under the Act of Congress sufficiently identify its mark, already then in existence and in use by it, so as to enable the Federal Courts to determine what it is and to enforce it?

IV. Sec. 1 of the Act provides that "owners of trade marks" may obtain registration by causing to be recorded in the Patent Office, among other things, "a description of the trade mark itself, *facsimiles* thereof, and a statement of the mode in which the same is applied and affixed to the goods."

Of course, the purpose of all this is identification. In determining whether complainant's mark is identified in the certificate of registration this court will care-

fully examine the whole document and will not be astute to give an interpretation that will result in a forfeiture of any of complainant's rights.

The statute under which the registration was made is a remedial one and will be beneficently construed to preserve the right and advance the remedy.

In the "statement" of the certificate the solicitor for the registrant began as follows: (p. 7)

> "The trade mark consists of a red or other distinctively-colored streak applied to or woven in a wire rope. The color of the streak may be varied at will, so long as it is distinctive from the color and body of the rope."

This, standing alone, was rather indefinite and left the questions: What kind of a streak? What does it look like? unanswered.

The draftsman of the document then made another trial (p. 7)

> "The essential feature of the trade mark is a streak of distinctive color produced or applied to a wire rope.
>
> "This mark is usually applied by painting one strand of the wire rope a distinctive color, usually red."

This was better. An idea of the appearance sought to be described begins to dawn upon one reading this statement. The mark is to be "applied by painting one strand of the wire rope a distinctive color, usually red." This, of course, assumes a knowledge on the part of the reader of the appearance of a wire rope, with its spirally twisted strands; but, with that assumption, it clearly indicates that one of the spiral strands is to be painted a distinctive color, preferably red, so as to give

the appearance of a spiral of distinctive contrasting color applied to the rope.

The draftsman of the statement had the pictorial representation or *facsimile*, of the mark before him which now appears as a part of the certificate (opp. p. 7), and assumed, naturally, that what he was writing would be read in connection therewith. So read, the meaning of the language is perfectly plain, for the distinctively spiral line of contrasting color applied to one strand of the rope is as clearly indicated, even by the black and white drawing of the *facsimile*, as though there were written on the dark strand "This is the streak of contrasting color applied to one strand of the rope, mentioned in the accompanying statement, which constitutes the trade mark."

But more than this. In the sworn declaration which accompanied the statement the registrant made oath: (p. 8)

> "that the *description and facsimile* presented for record truly represent the trade mark sought to be registered."

It will be noted that the declaration was *not* that the *description*, alone, truly represented the trade mark sought to be registered, but that "*the description and facsimile*" both taken together, "*truly represent*" such mark. This is the kind of declaration required by Sec. 2 of the act which says the applicant must declare "that the description and facsimiles presented for registry truly represent the mark sought to be registered."

The act, in Sec. 4, further provides for the certification of the *trade mark* in addition to the statements and declarations filed therewith.

Giving, then, all parts of the certificate due consideration, the drawing or *facsimile*, as well as the descrip-

tion, it seems clear that the trade mark identified by the certificate is indubitably and indisputably the same mark as that set forth in the bill of complaint as the mark that complainant has so extensively used and which has come to be so widely recognized and acquiesced in as identifying its wire rope from that produced by other manufacturers.

Certainly, no fair minded person examining the certificate, as a whole, both description and *facsimile*, with the honest intention and desire of ascertaining what the real trade mark was that applicant had adopted and sought to disclose would fail to see that it was a spiral streak of distinctive contrasting color applied to a wire rope, and that the usual mode of applying said spiral streak was to paint one and one only, of the spiral strands of the rope itself.

If, therefore, it be conceded, as we think it must be, that complainant's trade mark as actually used is sufficiently identified by the certificate of registration, it follows that complainants registration was valid and should be upheld and the protection of the Federal Courts should not be denied it.

V. The courts below, while apparently of the opinion that color could not be seriously considered as entering into the composition of a trade mark, nevertheless, with some inconsistency, criticised the sufficiency of complainant's registration because the statement declared that red was the color "usually" employed for the spiral streak in complainant's trade mark, thereby implying that colors, other than red, might be used, and held that, because of this alleged indefiniteness, the registration was invalid.

In reply, we submit that complainants trade mark

is, at least, good for the color, red, specifically designated as the one usually employed.

Whether or not a spiral streak of some other color and differing from compainants *only* in color would be substantially the same as complainant's red spiral streak is a question of fact that may never arise. It certainly is not put in issue by the demurrer.

If in the registration of a trade mark for cotton goods, consisting of the figure of an anchor, the applicant should say, in his statement, that his mark consisted of the picture of an anchor, which was *usually* printed in red color upon his goods, or if, in the registration of a trade mark for soap, consisting of the word Sapolio, the applicant should say that his mark consisted of the word Sapolio, which he usually applied in form of red letters to the wrappers containing his soap, and it should appear, in a suit brought under the first named registration, that an infringer had used the same identical figure of an anchor printed in *blue*, or, in a suit brought under the other registration that the infringer had used on his wrappers the word Sapolio printed in *blue*, would this court, or any court, hold that there had been no infringement of the vital and substantial feature of the mark. Surely not. So, in the case at bar, should it ultimately appear that the defendant used the same identical device of a distinctive spiral streak of contrasting color applied to one of the spiral strands of its wire rope, but instead of a red streak, employed a blue "streak," and by reason of the employment of such blue streak succeeded in confusing the public and in diverting and running away with complainant's trade, would this court hold that it had not infringed? How swift would defendant's punishment be in such a case.

But, as we have said, the question of whether or not one color is the equivalent of another has not yet arisen in this case. Complainant's mark must be sustained as good, and its registration as valid, if said mark shall be found good as covering the spiral streak of the specific contrasting color which it has used as a trade mark.

VI. The criticism that complainant's trade mark is *descriptive* can hardly be dealt with with patience.

A descriptive trade mark is one that describes the article or the quality of the article to which it is applied, or the place where the article is produced, as, for instance, "Iron Bitters" (Brown Chemical Co. v. Meyer, 139 U. S. 540); "Goodyear Rubber" (Goodyear India Rubber Glove Mfg. Co. v. Goodyear Rubber Co. 128 U. S. 598) "Lackawanna Coal" (Canal Co. v. Clark 13 Wall. 311); "Elgin Watch Cases" (Elgin Nat. Watch Co. v. Illinois Watch Case Co. 179 U. S. 665).

If a trade mark is descriptive because it is described in the application for Federal registration of it, as required by the statute, then the mark in this case is descriptive; but not otherwise.

VII. The courts below also seem to have conceived the notion that because complainant has applied its distinctive streak of contrasting color to a spiral strand of its rope and to such strand throughout the length of the rope, it has thereby taken the mark out of the category of legitimate trade marks.

Nothing, we submit, could be further from the truth. The application of the streak of color to a strand of the rope was only incidental. It might be, for convenience, applied in that way, as shown in Plate I, at the end of this brief, or to parts of two adjacent strands, as shown

on Plate II, or reversely, across all the strands, as shown in Plate III. But, in all these variations, the distinctive character of the mark is preserved. It is still a spiral streak of contrasting color and would be recognized, anywhere, as complaintant's distinctive mark.

As to the running of the spiral streak of color throughout the entire length of the rope, it can hardly be seriously contended that a trade mark which is a good one when applied to the first few feet of a coil of rope is not equally good when applied to each and every segregable part of the whole coil. If complaintant's spiral streak of contrasting color were applied to but one end of its coils of rope, a dishonest merchant, known to deal in complaintant's goods, might palm off an indefinite amount of rope of inferior quality upon an unsuspecting purchaser by simply representing that the article sold was part of a coil of complaintant's rope from which the trade-mark-end had been cut; but by applying the trade mark to every part of the coil, every segregated inch points to its origin, to complainant as the manufacturer, and the purchaser is enabled to see with his own eyes that he is getting just what he de sires and pays for.

Another example of the continuous application of a trade mark to an article produced in lengths, is afford-ed by the well known water-marking of paper, where the paper, as it is produced in continuous lengths, re-ceives the water mark, and every sheet cut from the length shows the mark, or some portion of it, the mark-ing thus becoming the symbol of authenticity.

VIII. The bill tells us that the identical mark cover-ed by complainant's registration was claimed to belong to the defendant in this case; that the defendant made an application for registration of the same in the Pat-

ent Office; that an interference was declared between complainant and defendant by the Commissioner of Patents under the statute; and that Complainant's priority of adoption and use was decreed, first by the Examiner and then, finally by the commissioner of Patents on appeal.

The Act of March 3, 1881, says: (See 3)

> "In an application for registration the Commissioner of Patents shall decide the presumptive lawfulness of claim to the alleged trade mark; and in any dispute between an applicant and a previous registrant, or between applicants, he shall follow, so far as the same may be applicable the practice of courts of equity of the United States in analogous cases."

The Act, therefore, lodges a part of the judicial power of the Government in the Commissioner of Patents.

> Bernardin v. Seymour, 10 App. D. C. 294.
> U. S. v. Duell, 172 U. S. 576.

The judgment of the Commissioner of Patents, acting as a judicial officer, in favor of complainant, on the question of priority of adoption, necessarily involved a decision of the validity of the trade mark in question, for he could not find priority in respect of an invalid trade mark any more than he could find priority in respect of an *unpatentable* invention.

> Hill v. Wooster, 132 U. S. 693.

The Commissioner, having therefore, in a judicial proceeding authorized by Statute, decided the trade mark here in dispute to be a lawful and valid trade mark and to belong to the complainant, the defendant herein, in this judicial proceeding, between the same par-

ties, in respect of the same subject matter, and under the same statute, cannot now be heard to question the validity of that mark. The matter has become *res adjudicata.*

Aurora City v. West, 7 Wall. 82
Last Chance Min. Co. v. Tyler Min. Co. 157 U. S. 683.
Hanford v. Westcott, Fed. Case. No. 6022.

IX. The decrees of the courts below should be reversed, with directions to reinstate complainant's bill of complaint and to order defendant to answer the same.

HERVEY S. KNIGHT,
MELVILLE CHURCH.
*Counsel for Appellant.*

Jan. 19, 1906.
Washington, D. C.,

# Plate I.

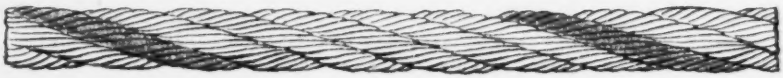


PLATE II.

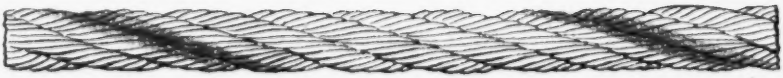
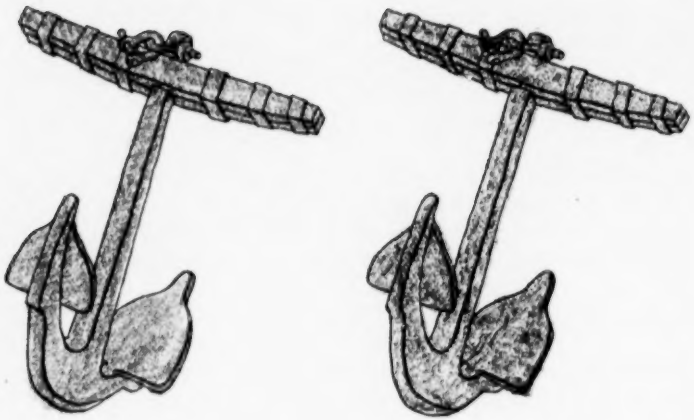


PLATE III.



PLATE IV.



SAPOLIO SAPOLIO

# Supreme Court of the United States.

No. 187.—October Term, 1905.

A. Leschen & Sons Rope Company, Appellant, vs. Broderick & Bascom Rope Company. } Appeal from the United States Circuit Court of Appeals for the Eighth Circuit.

[March 19, 1906.]

This was a bill in equity brought in the Circuit Court for the Eastern District of Missouri by the appellant, a Missouri corporation, against the appellee, another Missouri corporation, for the infringement of a trade-mark for wire rope, registered under the Act of Congress of March 3, 1881. (21 Stat. 502.)

The bill alleged that the plaintiff, the A. Leschen & Sons Rope Company, in 1888 had "adopted for its use as a trade-mark for its highest and best grade of wire rope, a strand of a different color from the other strands of the rope, the said trade-mark then and now being effected by your orator by painting one of the strands of the rope so as to make it distinctly unlike the other strands of the rope;" that it had continuously used the trade-mark to the present day; that it had been extensively advertised; that its sale had been very great, and that the company had obtained, December 4, 1900, a registration of such trade-mark in the office of the Commissioner of Patents.

The bill further averred that early in the year 1900 the defendant company "commenced to paint one of the strands of its wire rope so as to make it of a distinctly different color from the other strands of the rope;" that on October 31, 1900, it applied to the Commissioner of Patents for a registration; that the Commissioner declared an interference with the plaintiff, upon which proofs were taken, the case fully argued, and plaintiff was declared to be the first to adopt the trade-mark; that notwithstanding this, defendant continued its unlawful use of this trade-mark with the intent to defraud plaintiff, to deceive the public, and to take unfair advantage of the demand for plaintiff's wire ropes, and that said mark is being used by said defendant to make sales of rope upon the strength of plaintiff's reputation. The bill further alleged the use of the trade-mark by both parties in commerce between the United States and foreign countries.

Defendant demurred on the ground that the trade-mark set up in the bill was not a lawful and valid trade-mark. The demurrer was sustained,

the bill dismissed, (123 Fed. Rep. 149,) and the decree of the Circuit Court affirmed by the Circuit Court of Appeals. (134 Fed. Rep. 571.)

Mr. Justice BROWN delivered the opinion of the Court.

As both parties are citizens of the State of Missouri, the jurisdiction of the Circuit Court can only be sustained upon the theory that the case is one arising under the Constitution and laws of the United States.

By an act of Congress of July 8, 1870, (16 Stat. 198–210, sec. 77,) to revise the statutes relating to patents and copyrights, (R. S. sec. 4937,) permission was given citizens of the United States and some others, "who are entitled to the exclusive use of any lawful trade-mark, or intend to adopt and use any trade-mark for exclusive use within the United States," to obtain registration of such trade-mark in the Patent Office; and by Act of August 14, 1876, (19 Stat. 141,) a punishment was provided for a fraudulent use of such trade-marks by others. But in the *Trade-mark Cases*, (100 U. S. 82,) this legislation was declared to be unconstitutional upon the ground that it was intended to embrace all commerce, including that between citizens of the same State; and it was held that, if the power of Congress extended to the registration of trade-marks at all, it must be limited to their use in commerce with foreign nations and between the several States and with the Indian tribes.

Apparently in consequence of this decision, Congress, by Act of March 3, 1881, (21 Stat. 502,) passed a new act, declaring that the "owners of trade-marks used in commerce with foreign nations, or with the Indian tribes, provided such owners shall be domiciled in the United States, or located in any foreign country, or tribes, which by treaty, convention, or law, affords similar privileges to citizens of the United States, may obtain registration of such trade-marks . . . by causing to be recorded at the Patent Office a statement specifying name, domicil, location, and citizenship of the party applying; . . . a description of the trade-mark itself with fac-similes thereof, and a statement of the mode in which the same is applied and affixed to goods," etc.

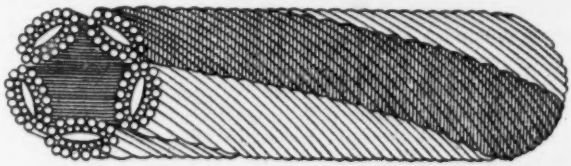
The registration of the trade-mark in question contains the following description:

"The trade-mark consists of a red or other distinctively colored streak applied to or woven in a wire rope. The color of the streak may be varied at will, so long as it is distinctive from the color and body of the rope.

"The essential feature of the trade-mark is the streak of distinctive color produced in or applied to a wire rope.

"This mark is usually applied by painting one strand of the wire rope a distinctive color, usually red."

It is true that the drawing annexed to the registration, a copy of which is here given, as well as the exhibits furnished, show one of the strands



colored red; and if the trade-mark were restricted to a strand thus colored, perhaps it might be sustained; but the description of a colored streak, which would be answered by a streak of any color painted spirally *with* the strand, longitudinally *across* the strands, or by a circular streak around the rope, was held by both Courts, and we think properly, too indefinite to be the subject of a valid trade-mark. Certainly a trade-mark could not be claimed of a rope, the entire surface of which was colored; and if color be made the essential feature, it should be so defined, or connected with some symbol or design, that other manufacturers may know what they may safely do. Upon the plaintiff's theory, a wire rope containing a streak of any description or of any color would be an infringement, and a manufacturer honestly desiring to distinguish his wire rope from that of the plaintiff's by difference in color might, by adopting a white streak running along the length of the rope across the strands, find himself an infringer, when his real object may have been to obtain a mark which would distinguish his manufacture from that of the plaintiff's. Even if it were conceded that a person might claim a wire rope colored red or white, or any other color, it would clearly be too broad to embrace all colors. So, although it might be possible to claim the imprint of a colored figure on a wire rope, the figure should be so described that other manufacturers would know how to avoid it. If the trade-mark be a colored streak, it should be, at least, described and a statement of the mode in which the same is applied and affixed to the rope; and a trade-mark which may be infringed by a streak of any color, however applied, is manifestly too broad.

It would not aid plaintiff's case even if it were shown that it made use of a colored strand, and that defendant made use of a strand similarly colored, since the trade-mark must stand or fall in its entirety, and if the description therein be too broad, it cannot be sustained by showing that defendant imitated its color and its method of applying it. Perhaps, however, the defendant might be liable under a bill framed upon the theory that it was endeavoring to dispose of its goods as those of the plaintiff.

Whether mere color can constitute a valid trade-mark may admit of doubt. Doubtless it may, if it be impressed in a particular design, as a circle, square, triangle, a cross, or a star. But the authorities do not go farther than this. In the case of *Handon's Trade-mark*, (37 Chan. Div. 112,) in which a trade-mark was claimed for a red, white and blue label, in imita-

tion of the French tri-color, for French coffee, it was held not entitled to registration under the English statute, which requires a trade-mark to be distinctive in order to be valid. The Court remarked as follows:

"It is the plain intention of the act that, where the distinction of a mark depends upon color, that will not do. You may register a mark, which is otherwise distinctive, in color, and that gives you the right to use it in any color you like; but you cannot register a mark of which the only distinction is the use of a color, because practically under the terms of the act that would give you a monopoly of all the colors of the rainbow."

It is unnecessary to express an opinion whether, if the trade-mark had been restricted to a strand of rope distinctively colored, it would have been valid. As already observed, the claim is much broader than this. Nor can we assume jurisdiction of this case as one wherein the defendant had made use of plaintiff's device for the purpose of defrauding the plaintiff and palming off its goods upon the public as of the plaintiff's manufacture. Our jurisdiction depends solely upon the question whether plaintiff has a registered trade-mark valid under the act of Congress, and, for the reasons above given, we think it has not.

*Affirmed.*

True copy.

Test:

*Clerk Supreme Court, U. S.*